

## **REMARKS**

### **A. Status of the Claims**

Claims 40-50 were pending at the time of the Action. Claims 40-47 have been canceled and the same subject matter resubmitted as new claims 57-64. Claims 49 and 50 have been canceled without prejudice or disclaimer. Thus, claims 48 and 57-64 are currently under examination. No new matter has been added by these amendments.

### **B. The Objection Under 37 C.F.R. § 1.75(c) Is Overcome**

The Action objects to claims 40-47 under 37 C.F.R. § 1.75(c) as being of improper dependent form because they refer back to a numerically following claim. The MPEP states that “in situations where a claim refers to a numerically following claim and the dependency is clear, both as presented and as it will be renumbered at issue, *all claims should be examined on the merits and no objection as to form need be made*. In such cases, the examiner will renumber the claims into proper order at the time the application is allowed.” MPEP § 608.01(n)(F) (emphasis added). Although claims 40-47 depend, either directly or indirectly, from claim 48, their dependency is clear. Applicants, however, canceled claim 40-47 and are resubmitting the same subject matter as new claims 57-64. The objection under 37 C.F.R. § 1.75(c) is, therefore, moot.

### **C. The Nonstatutory Double Patenting Rejections Are Overcome**

The Action rejects claims 40-43 and 48 (currently claims 57-60 and 48) on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-13 and 15-17 of U.S. Patent No. 6,383,806. The Action further rejects claims 44-47 (currently claims 61-64) on the same ground as being unpatentable over claims 11-13 and 15-17 of U.S. Patent No. 6,383,806 and further in view of Ferrari *et al.* (1997). Accompanying this response, Applicants

are filing a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c). The rejections, therefore, are overcome.

**D. The Claims Are Enabled by Adequate Written Description in the Specification**

The Action rejects claims 49 and 50 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is moot in view of the cancellation of claims 49 and 50.

With respect to claim 50, which is directed to a method of vaccination, the Action alleges that it would require undue experimentation to make and use the claimed method (Office Action, p. 6). In rejecting claim 49, the Action asserts that it is not enabled because the only disclosed use of the viral particle with respect to humans was for vaccination (Office Action, p. 6). Although Applicants disagree with this rejection, claims 49 and 50 have been canceled in order to advance the prosecution of this case. Applicants reserve the right to pursue such subject matter in later continuing applications, or to reintroduce in the present prosecution should the Examiner raise yet further issues.

Applicants note that vaccinating a subject requires eliciting an immune response in the subject. Thus, someone who vaccinates a subject by obtaining and administering to the subject a viral particle comprising a reverse transcriptase that has been inactivated by binding said reverse transcriptase with one or more azido-labeled compounds and then irradiating said reverse transcriptase, would still be practicing the method of claim 48. Additionally, since a human is a subject, anyone who elicits an immune response and/or vaccinates a human according to this method would still be practicing the method of claim 48. Applicants further note that the passages of the specification quoted in the Action do not state that vaccination is the only use of the immunogenic composition in humans; rather, they recite what one “may” do or “contemplates” doing. The Specification clearly contemplates other utilities of the claimed

invention in an animal, wherein the animal can be a human. For example, on page 13, lines 16-18, the Specification states that "Another aspect of the present invention is a method of delaying the onset of AIDS in an animal exposed to infectious HIV . . . . The animal may be a mammal and in preferred embodiments the mammal is a human ...." Thus, the immune response may provide a therapeutic benefit in delaying the onset of AIDS even though it may not cure AIDS or prevent an infection by HIV.; The specification also teaches that an immune response may be elicited to generate antibodies, which may then be used for purposes such as determining the presence of retroviral antigens in a sample (p. 14, ln. 14-18). Applicant also would like to clarify that in the discussion of claim breadth on page 8 of the Action, the Action represents that herpesviruses and adenoviruses have a reverse transcriptase, which they do not.

In view of the above, Applicants respectfully request the withdrawal of this rejection.

**E. Conclusion**

Applicants believe that this is a full and complete response to the Office Action mailed July 10, 2009. Should the Examiner have any questions, comments, or suggestions relating to this case, the Examiner is invited to contact the undersigned Applicants' representative at (512) 536-5654.

Respectfully submitted,



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